

REMARKS

Claims 1-15 are currently pending in the Application. Claims 1, 5 and 9 are independent claims. Claims 2-4, 6-8 and 10-15 depend from independent claims 1, 5 and 9, respectively. Claims 1-9 are currently amended to correct minor informalities. The Applicant respectfully requests reconsideration of pending claims 1-15, in light of the following remarks.

Specification Amendments

Paragraph [09] in the specification has been amended to correct typos. Specifically, “a second server blade” was amended to recite “a server blade”; “the second blade server” was amended to recite “the server blade”; “a third switch blade” was amended to recite “a second switch blade associated with a third multiserver platform”; “the second switch blade” was amended to recite “a third switch blade associated with the second multiserver platform”; and “the second switch blade” was amended to recite “the third switch blade.” The Applicant asserts that no new matter was added in amending paragraph [09] in the specification.

Claim Amendments

Claims 1-9 are currently amended to correct minor informalities. Claims 1, 5 and 9 are amended to correct minor informalities objected to in the Office Action. Additionally, claims 1-8 are currently amended to address a typo and antecedent issues. Specifically, “second server blade” in claims 1 and 5 was amended to recite “server blade” because a “first server blade” is not recited in the claims. Further, “a third switch blade” in claims 2 and 6 was amended to recite “a second switch blade associated with a

third multiserver platform” because a “second switch blade” had not yet been recited in the claims. Also, “said second switch blade” in claims 3 and 7 was amended to recite “a third switch blade associated with said second multiserver platform” to correct antecedent issues. Additionally, “second blade server” in claims 4 and 8 was amended to recite “server blade” because a “first blade server” is not recited in the claims.

Claim Objections

On page 2 of the Office Action, independent claims 1, 5 and 9 were objected to for minor informalities. Additionally, dependent claims 2-4, 6-8 and 10-15 were objected to for depending upon the objected claims. The Applicant respectfully traverses the objections, however, in order to advance prosecution in the application, the Applicant has amended claims 1, 5 and 9 to correct the noticed minor informalities. The Applicant respectfully asserts that the minor amendments to dependent claims 1, 5 and 9 do not alter the scope of the claims as originally presented, but rather address antecedent issues (e.g., claims 1 and 5) or corrects a typo (e.g., claim 9).. The Applicant believes the amendments to independent claims 1, 5 and 9 have overcome the noticed minor informalities and therefore respectfully requests that the objections to claims 1-15 be withdrawn.

Rejections Under 35 U.S.C. §101 - Specification

On page 3 of the Office Action, claims 1-15 were rejected under 35 U.S.C. §101 as being non-statutory subject matter. The Applicant respectfully traverses the rejections for at least the following reasons.

The Office Action states the following:

In the specification, on page 18, Para 57, applicant states, "...invention may be realized in hardware, software, or a combination of hardware and software.". If the invention is implemented in software then it is non-statutory, because software is neither machine, process, composition of matter, nor article of manufacture, Therefore, claims 1-15 are rejected as non-statutory subject matter.

(Office Action, Page 3, Point 3, Lines 3-8). However, claim 1 is directed to "[a] method for communicating information in a server platform...", claims 2 and 4 are directed to "[t]he method according to claim 1...", and claim 3 is directed to "[t]he method according to claim 2..." (See Applicant's claims 1-4). Clearly, method claims 1-4 are a "process" under 35 U.S.C. §101 and therefore, constitute statutory subject matter. Further, claim 5 is directed to "[a] machine-readable storage...", claims 6 and 8 are directed to "[t]he machine-readable storage according to claim 5...", and claim 7 is directed to "[t]he machine-readable storage according to claim 6." (See Applicant's claims 5-8). Clearly, machine-readable storage claims 5-8 are a "machine" and/or "manufacture" under 35 U.S.C. §101 and therefore, constitute statutory subject matter. Also, claim 9 is directed to "[a] system for communicating information in a server platform...", claims 10 and 13 are directed to "[t]he system according to claim 9...", claims 11 and 12 are directed to "[t]he system according to claim 10...", claim 14 is directed to "[t]he system according to claim 13...", and claim 15 is directed to "[t]he system according to claim 14..." (See Applicant's claims 9-15). Clearly, system claims 9-15 are a "machine" and/or "manufacture" under 35 U.S.C. §101 and therefore, constitute statutory subject matter. Because claims 1-15 are directed to a "process," "machine" and/or "manufacture," claims 1-15 are statutory subject matter under 35 U.S.C. §101 and therefore, rejections of claims 1-15 under 35 U.S.C. §101 cannot be maintained.

Rejections Under 35 U.S.C. §101 – Claims 1-4

On pages 3 and 4 of the Office Action, independent claim 1 and dependent claims 2-4 were further rejected under 35 U.S.C. § 101, because the claimed invention is directed to non-statutory subject matter (i.e., statutory method claims with a judicial exception of implementing an abstract idea). The Applicant respectfully traverses the rejections for at least the following reasons.

The Office Action states that claims 1-4 are rejected under 35 U.S.C. § 101 because claims 1-4 “are statutory method claims with a judicial exception of implementing an abstract idea (receiving, determining, and routing, etc.) having no tangible output, i.e. the packets are moved around with in [sic] the multi-server platform, without leaving the multi-server platform.” The Applicant respectfully submits that the rejection under 35 U.S.C. § 101 is improper since the Applicant’s claimed invention produces a useful, tangible and concrete result, and has a practical application.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). *Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable.

See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) (“idea of itself is not patentable, but a new device by which it may be made practically useful is”); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) (“While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 (“steps of ‘locating’ a medial axis, and ‘creating’ a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic ‘abstract idea’”).

An Examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” See *Diehr*, 450 U.S. at 187, 209 USPQ at 8; accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675. Thus, “[w]hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.” *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9 (quoting *Mackay*, 306 U.S. at 94); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1854) (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.” The claim must be examined to see if it includes anything more than a § 101 judicial exception. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the

Examiner does not find such a practical application, the Examiner has determined that the claim is nonstatutory.

In determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the Examiner should consider and weigh the following factors:

1. Useful Result

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of “specific” and “substantial”).

2. Tangible Result

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. See Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” See Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.”

3. Concrete Result

Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. See *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*.

The Examiner should review the totality of the evidence (e.g., the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. The Examiner must weigh the determinations made above to reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter. **“The Examiner bears the initial burden ... of presenting a prima facie case of unpatentability.”** See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, the Examiner should not reject the claim.**

After the Examiner identifies and explains in the record the basis for why a claim is for an abstract idea with no practical application, then the burden shifts to the Applicant to either amend the claim or make a showing of why the claim is

eligible for patent protection. See, e.g., *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP § 2107 (Utility Guidelines).

The Applicant respectfully asserts that the Office Action has not established a prima facie case of unpatentability since the Office Action has not identified and explained **“the basis for why a claim is for an abstract idea with no practical application.”** Specifically, the Office Action fails to set forth a basis why Applicant’s independent claim 1 has no practical application. Accordingly, the burden has not shifted to the Applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). See also, generally, MPEP § 2107.

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant’s invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and *Fisher*, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 1-4 provides a practical application that produces a useful result, i.e., a method for communicating information in a server platform.**

With regard to concrete results, an appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that the claims specifically set forth a practical application to produce a real-world result. **The real-world (i.e., tangible) result being the at least one packet not previously available**

on the at least said second server blade becomes available at the at least said second server blade. The Office Action alleges that claims 1-4 “hav[e] no tangible output, i.e. the packets are moved around with in [sic] the multi-server platform, without leaving the multi-server platform.” However, nothing in the section 101 or the relevant case law requires an output (i.e., the packets need not leave the multi-server platform to be tangible). **Rather, the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result.** See Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” See Diehr, 450 U.S. at 187, 209 USPQ at 8; see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted . . .”). **As mentioned above, claims 1-4 set forth a practical application (i.e., a method for communicating information in a server platform) to produce a real-world result (i.e., the at least one packet not previously available on the at least said second server blade becomes available at the at least said second server blade).**

Because the Office Action has not established a prima facie case of unpatentability since the Office Action has not identified and explained “the basis for why a claim is for an abstract idea with no practical application,” and because claims 1-4 set forth a practical application to produce a real-world result, the rejection under 35 U.S.C. § 101 cannot be maintained. Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn.

Rejections Under 35 U.S.C. §102(b) – CISCO

In point 5 on pages 4 through 11 of the non-final Office Action, independent claims 1, 5 and 9 and dependent claims 2-4, 6-8 and 10-15 were rejected under 35 U.S.C. §102(b)

as being anticipated by CISCO systems, Virtual LAN Communications, July 14, 1995, CISCO Systems, 3, 8 and 9 (hereinafter "CISCO"). The Applicant respectfully traverses the rejections for at least the following reasons.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claims 1 and 5, the Applicant respectfully submits that CISCO fails to teach, suggest, or disclose, for example, "receiving at least one packet from at least one of **a first switch blade** associated with **a first multiserver platform**; determining at least **a server blade** associated with **a second multiserver platform** for receiving at least a portion of said received at least one packet; and routing said at least a portion of said at least one received packet to at least **said server blade**."

With regard to receiving at least one packet from at least one of a first switch blade associated with a first multiserver platform, the Office Action states "see Page 9, Figure 9, left hand side bottom switch is first blade switch and multiserver platform is one under label VLAN1; it is inherent with network interface that any packet originated by the multiserver will be received by the first blade switch." (Office Action, Page 4, Last Paragraph, Lines 1-6). However, CISCO fails to disclose a first switch blade or a first multiserver platform. Nowhere in the CISCO reference is there any mention of using switch blades or server blades. Rather, the CISCO reference discloses using the Catalyst 5000 and ProStack switches, which are not switch blades.

Additionally, nowhere in the CISCO reference is there any mention of a multiserver platform. CISCO's VLAN1 in Figure 9 is different than a multiserver

platform. A multiserver platform is disclosed in Applicant's specification in, for example, at least Figure 1 and accompanying text in paragraphs 22-28.

With regard to determining at least a server blade associated with a second multiserver platform for receiving at least a portion of said received at least one packet, the Office Action states the following:

[S]ee Page 9, Figure 9, The second blade switch is left top switch and multiserver platform is the one under VLAN1; when a packet is received from first multiserver platform is received by the switch, the switch will determine (determination is made by rules set by administrator) if the packet is to be sent to second multiserver platform, "Both of these techniques examine the packet when it is either received or forwarded by the switch. Based on set of rules defined by the administrator...", Page 3, third Para, lines 4-6).

(Office Action, Page 5, First Paragraph, Lines 1-10 (emphasis original)). However, the Office Action confuses a "server blade" with a "blade switch." A server blade is different than a switch blade. (See e.g., Figure 1 Blade Server 120 compared to Switch Blade 140 and accompanying text in paragraphs 25-27). Additionally, as mentioned above, CISCO fails to disclose a server blade, a switch blade or a multiserver platform. Nowhere in the CISCO reference is there any mention of using server blades. Additionally, nowhere in the CISCO reference is there any mention of a multiserver platform. CISCO's VLAN1 in Figure 9 is different than a multiserver platform. A multiserver platform is disclosed in Applicant's specification in, for example, at least Figure 1 and accompanying text in paragraphs 22-28.

With regard to routing at least a portion of said at least one received packet to at least said server blade, the Office Action states the following:

Once the determination is made by the first blade switch, that packet belongs to multiserver platform connected to second switch blade, it will be sent (routed to) to [sic]

second blade that is associated with second multiserver platform, "Based on the set of rules defined by the administrator, these techniques determine where the packet is to be sent, filtered, and/or broadcast.", Page 3, third Para, Lines 5-7).

(Office Action, Page 5, Paragraph 2, Lines 1-8). However, as mentioned above, CISCO fails to disclose a first switch blade, a server blade or a first multiserver platform. Nowhere in the CISCO reference is there any mention of using switch blades or blade servers. Rather, the CISCO reference discloses using the Catalyst 5000 and ProStack switches, which are not switch blades. Also, the Office Action confuses a "server blade" with a "blade switch." A server blade is different than a switch blade. (See e.g., Figure 1 Blade Server 120 compared to Switch Blade 140 and accompanying text in paragraphs 25-27). Additionally, nowhere in the CISCO reference is there any mention of a multiserver platform. CISCO's VLAN1 in Figure 9 is different than a multiserver platform. A multiserver platform is disclosed in Applicant's specification in, for example, at least Figure 1 and accompanying text in paragraphs 22-28.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the CISCO reference fails to teach, suggest, or disclose Applicant's invention as set forth in claims 1 and 5. The Applicant believes that claims 1 and 5 are allowable over CISCO. Applicant respectfully submits that claims 1 and 5 are independent claims, and that claims 2-4 and 6-8 depend either directly or indirectly from independent claims 1 and 5, respectively. Because claims 2-4 and 6-8 depend from claims 1 and 5, respectively, Applicant respectfully submits that claims 2-4 and 6-8 are allowable over the CISCO reference, as well. The Applicant respectfully requests, therefore, that the rejection of claims 1-8 under U.S.C. §102(b), be withdrawn.

Regarding claim 9, the Applicant respectfully submits that CISCO fails to teach, suggest, or disclose, for example, "**a first multiserver platform** comprising at least one of **a network interface** and **a first switch blade**; and at least **a second multiserver**

platform comprising **a second switch blade** coupled to said first switch blade of said first multiserver platform.”

With regard to a first multiserver platform comprising at least one of a network interface and a first switch blade, the Office Action states the following:

[A] first multiserver platform (for this claim, Page 8, Figure 8, right hand side block will be used for claim elements; bottom row) comprising at least one of a network interface (multiserver [sic] platform first one in bottom row, under VLAN1 and a network interface connecting to the switch to the multiserver) and a first switch blade (bottom block of three switches, second one connected to first multiserver platform under the label VLAN1).

(Office Action, Page 7, Last Full Paragraph, Lines 1-7). As mentioned above, nowhere in CISCO is a multiserver platform disclosed. CISCO's VLAN1 in Figure 8 is different than a multiserver platform. A multiserver platform is disclosed in Applicant's specification in, for example, at least Figure 1 and accompanying text in paragraphs 22-28. Further, neither Figure 8 nor the supporting text in CISCO mentions a network interface. The Office Action fails to point out where in Figure 8 the network interface is disclosed. Additionally, as mentioned above, nowhere in the CISCO reference is there any mention of using switch blades or server blades. Rather, the CISCO reference discloses using the Catalyst 5000 and ProStack switches, which are not switch blades.

With regard to determining at least a server blade associated with a second multiserver platform for receiving at least a portion of said received at least one packet, the Office Action states the following:

[A]t least a second multiserver platform (second row) comprising a second switch blade (middle switch) coupled [to] said first switch blade of said first multiserver platform (middle switch connected to second multiserver platform, under the label VLAN1; both first multiserver platform and second multiserver platform are coupled by VLAN1).

(Office Action, Page 7, Last Paragraph through Page 8, Lines 1-3). However, as mentioned above, nowhere in CISCO is a multiserver platform disclosed. CISCO's VLAN1 in Figure 8 is different than a multiserver platform. A multiserver platform is disclosed in Applicant's specification in, for example, at least Figure 1 and accompanying text in paragraphs 22-28. Further, as mentioned above, nowhere in the CISCO reference is there any mention of using switch blades. Rather, the CISCO reference discloses using the Catalyst 5000 and ProStack switches, which are not switch blades.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the CISCO reference fails to teach, suggest, or disclose Applicant's invention as set forth in claim 9. The Applicant believes that claim 9 is allowable over CISCO. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-15 depend either directly or indirectly from independent claim 9. Because claims 10-15 depend from claim 9, Applicant respectfully submits that claims 10-15 are allowable over the CISCO reference, as well. The Applicant respectfully requests, therefore, that the rejection of claims 9-15 under U.S.C. §102(b), be withdrawn.

Applicant reserves the right to argue additional reasons supporting the allowability of claims 1-15 should the need arise in the future.

Appln. No. 10/647,963
Resp. to Office Action dated Mar. 27, 2007
Resp. filed Sept. 26, 2007

CONCLUSION

Applicant respectfully submits that all of claims 1-15 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: September 26, 2007

By: /Philip Henry Sheridan/

Philip Henry Sheridan

Reg. No. 59,918

McAndrews Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(T) 312 775 8000
(F) 312 775 8100